

**REMARKS**

The Office Action of May 18, 2005 has been carefully reviewed and considered by the Applicants. Claims 1, 2, and 8 have been amended. Claims 3-7 and 9-20 are pending. Reconsideration of the application is hereby respectfully requested.

**The Office Action**

The Examiner rejected claims 1-2 and 8 under 35 U.S.C. §101 as being directed to non-statutory subject matter.

Claims 1-8, 18, 19 and 20 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,810,143 to Nielson.

Claim 12 was rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 6,549,897 to Katariya in view of the Nielson patent.

Claims 9-11 and 13-17 were rejected under 35 U.S.C. §103 as being unpatentable over the Katariya patent in view of U.S. Patent No. 6,021,196 to Sandford.

**Response to 35 USC §101 Rejection**

The Examiner rejected claims 1-2 and 8 under 35 U.S.C. §101 as being directed to non-statutory subject matter. For the purposes of expediting prosecution of the application, and without any admission or concession on the correctness of the Examiner's position, Applicant has amended Claims 1, 2 and 8 to address the §101 rejection asserted by the Examiner. Claims 1 and 2 now recite a "document processing system," as in Claims 3 and 4, and a "document processing device" in claim 8. As such, the rejection should no longer be maintained. Favorable action is respectfully requested.

**Response to 35 USC §102 Rejection**

The Examiner rejected Claims 1-8 and 18-20 as being anticipated by the Nielson patent. However, Applicant respectfully submits that Claims 1, 2, and 8 are not anticipated, as asserted, because Nielson's patent does not include the feature of intents which indicate the relative importance of each document's properties.

More particularly, Nielson is a patent which relates to a single property which a document possesses, color. The patent governs color management. However, Claims 1 and 8 relate to intent data which covers several properties, which may include color.

Claims 1 and 8 are distinguishable over Nielson because, at the very least, they include information "indicative of relative importance of document properties." The Examiner states that the metric in Nielson "provides a quantitative value related to intents of a design of the document and indicative of relative importance of document properties related to the design." However, Nielson does not fairly indicate or teach relative importance, significance, weight, weightiness, distinction, value, worth or rank of the different properties. Claim 1 and 8 are, therefore, patentable because they include this element of a ranking of document properties. Therefore, Applicant respectfully requests that the Examiner remove the rejection of Claims 1-2 (Claim 2 is dependent on 1) and 8 based on the Nielson reference.

Applicant also respectfully submits that Claims 3-7 and 18-20 are unanticipated, as asserted, because Nielson does not anticipate all of the limitations of the Applicant's reference. In particular, the Examiner asserts that Nielson teaches the use of intent information. However, Nielson's use of the word intent is only in the context of "rendering intent." Nielson notes three examples of different types of rendering intent that the system can choose at the time of printing: perceptual, colorimetric, and saturation. Applicant's use of intent relates to a situation where the creator's, or editor's, intentions are captured in a quantified form. Applicant's Claims 3-7 and 18-20 all include the language of "document intent information representing intents of a design of the documents and being maintained to be used in decisions made to output the documents." Nielson does not fairly teach creator selected intents (such as, for example, legibility, cost or processing time) and their storage with the document's data information, as in the Applicant's Claims 3-7 and 18-20.

Moreover, in Nielson, although different "rendering intents" are discussed, it is done in the context of algorithms that convert Red, Green, & Blue (RGB) coding which is used by display screens to cyan, magenta, yellow, black (CMYK) which is used by printers. The program also discusses the use of intermediate conversion of color space, sometimes called the "CIELAB" color space when files are larger. It is submitted that the selection involved in Nielson's teaching involves the hardware selecting from the different "rendering intents." It is submitted that these selections may be made according to hardware parameters and do not fairly involve user or creator selection of the intents or storage of these creator selected intents with the data information. Therefore, Applicant respectfully requests that the Examiner remove the rejection based on Nielson with respect to Claims 3-7 and 18-20.

## **Response to 35 USC §103 Rejection**

### **Claim 12**

The Examiner rejected Claim 12 as being obvious in view of the combination of the Katariya patent and the Nielson patent. However, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. Applicant submits that Claim 12 is not obvious because the Examiner's references do not recite "document intent information representing intents of a design of the documents and being maintained to be used in decisions made to output the documents."

In Nielson, although different "rendering intents" are discussed, as above, it does not render the claims obvious. As above, the selection involved in Nielson's teaching apparently involves the hardware selecting from the different "rendering intents." It is submitted that these selections may be made according to hardware parameters and involve no user or creator selection of the intents or storage of these creator selected intents with the data information. In Katariya, a system for generating a weight for phrases within documents is disclosed. As such, the teachings of Nielson and Katariya are not combinable. In addition, even if the teachings were combinable, the suggested combination would lack intent information representing intents of a design of the documents, as contemplated by this application. Therefore, Applicant respectfully requests that the Examiner remove the rejection based on Nielson and Katariya with respect to Claim 12.

### **Claims 9-11 and 13-17**

Claims 9-11 and 13-17 were rejected as being obvious in view of Katariya and Sandford. However, as will be detailed below, these claims are not rendered obvious by the suggested combination.

First, Applicant submits that the Examiner failed to present a convincing argument to justify his motivation to combine the references. "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." MPEP § 2143.01. The Examiner fails to establish a convincing motivation to combine the references. The Examiner also fails to show any relationship between the problem, which is solved by the use of intent parameters, to the prior art references, which are

addressed to embedding data in a digital image and counting the frequency of occurrences of phrases. Due to the lack of connection between the problems solved by Applicant's invention and the cited references, Applicant respectfully submits that there is no motivation for one skilled in the art to combine without hindsight.

In addition, Applicant submits that the Examiner's use of the Sandford patent in the combination is improper because it is vastly different from the teachings of Katariya.

Sandford begins with a digital image and then embeds within that same digital image data a large amount of unrelated data into bits that represent the pixels of the digital image without altering the appearance of the digital image. Katariya relates to weighting phrases in a document. Because Sandford is so structurally and functionally different, it is submitted that its combination with Katariya is not possible. Applicant respectfully submits that the Examiner inappropriately applied hindsight to the combination. MPEP § 2145.

Second, even if the suggested combination could be realized, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03. At the very least, the Examiner does not persuasively address the recitation of the document intents. The Examiner cites Katariya, Fig. 1 [114c] as analogous to the quantitative document intent. However, 114c is a "phrase document weight matrix," not a user specified intent. Also, Katariya deals with a method for determining the importance of particular phrases by simply counting the occurrence of each phrase in the data and storing it. Applicant's system contemplates that the creator\ editor enter their intents for the document. These intents are then stored with the data file for latter possible use in outputting the data. Applicant submits that the recitation in its independent claims, e.g. Claims 9, 12, 13,18, 19, and 20, relating to "the document intent information representing intents of a design of the documents and being maintained to be used in decisions made to output the documents" is found nowhere in Katariya or Sandford. Therefore, even if the references could somehow be combined as suggested, they do not render the claims obvious.

Therefore, Applicant respectfully submits that its independent Claims 9, 12, 13,18, 19, and 20 and the associated dependent Claims 10, 11, 14, 15, 16, and 17 should be allowed.

**CONCLUSION**

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 1-20) are now in condition for allowance.

Respectfully submitted,

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